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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/727,224

12/03/2003

Asit Dan

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04/07/2009

LAW OFFICE OF IDO TUCHMAN (YOR)

ECM #72212

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EXAMINER

LIM, KRISNA

ART UNIT

PAPER NUMBER

2453

NOTIFICATION DATE

DELIVERY MODE

04/07/2009

ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary	Application No. 10/727,224	Applicant(s) DAN ET AL.	
	Examiner Krisna Lim	Art Unit 2453	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 July 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-31 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-31 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

1. Claims 1-31 are still pending for examination.
2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. §102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351 (a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21 (2) of such treaty in the English language.
3. Claims 1-31 are rejected under 35 U.S.C. §102(e) as being anticipated by Van Dordick et al.[U.S. Patent No. 2004/0230459]. This reference has been used in the previous office action.
4. Dordick et al. anticipates (e.g., see Figs. 1-3B) the invention substantially as claimed. Taking claim 1 as an exemplary claim, the reference anticipates a method for embedding an agreement (110, paragraph 36) between a device provider (104) and a device user (106) in a device, the method comprising:
 - a) monitoring (308-312 of Fig. 3A) at least one performance parameter (e.g., insurance risk metric); and
 - b) determining if an event specified in the agreement has occurred based on the parameter (e.g., see 310 of Fig. 3A, paragraph 39).
8. As to claim 2, Dordick et al. further anticipates if the event occurred indicating that the event occurred at the device (e.g., see paragraph 39).

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9. As to claim 3, Dordick et al. further anticipates storing the agreement (110 of Fig. 1, paragraphs 20-21) in the device (It is inherent that the agreement is stored in the device of Fig. 1)

10. As to claim 4, Dordick et al. further anticipates enforcing the agreement (110) at the device (e.g., see paragraphs 20-21).

11. As to claim 5, Dordick et al. further anticipates enforcing the agreement includes disabling at least some of the capabilities of the device if the event occurred (e.g., see paragraphs 20-21).

12. As to claim 6, Dordick et al. further anticipates enforcing the agreement includes enabling at least some of the capabilities of the device if the event occurred (e.g., see 314-316 of Fig. 3B).

13. As to claim 7, Dordick et al. further anticipates representing the agreement as a Boolean expression (logical operation) of at least one condition, the condition based on the parameter (e.g., see paragraphs 32 and 33).

14. As to claim 8, Dordick et al. further anticipates the event is a violation of the agreement (e.g., see paragraph 20, 21 and 24).

15. As to claim 9, Dordick et al. further anticipates indicating violation of the agreement on the device (e.g., see paragraph 37).

16. As to claim 10, Dordick et al. further anticipates informing the device provider of the event occurrence (e.g., see paragraph 27 and 37).

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17. As to claim 11, Dordick et al. further anticipates restricting access to parameter data (e.g., see paragraph 39).

18. As to claim 12, Dordick et al. further anticipates receiving the parameter data by manual entry (e.g., see paragraph 36).

19. As to claim 13, Dordick et al. further anticipates transmitting the parameter data to the device provider (e.g., see paragraph 36).

20. Claims 14-31 are rejected for the same rationale as claims 1-13, since they recite substantially identical subject matter. Any differences between the claims do not result in patentably distinct claims and all of the limitations are taught by the above cited references.

21. Applicant's arguments, see the applicant's remark, filed 7/8/08, with respect to the rejection(s) of claim(s) 1-31 under Dordick et al. have been fully considered and the rejection has been modified as indicated above.

Throughout the argument, applicant kept citing the portion of the reference that the Examiner referred to and stated that the citation did not teach the claimed language. Given the broadest interpretation of the claimed language and the applicant's responsibility to understand the whole the reference, not just the portion of the citation by the examiner, Examiner still believes that the claimed language is not patentable over the Dordick.

A shortened statutory period for response to this action is set to expire 3 (three) months and 0 (zero) days from the mail date of this letter. Failure to respond within the period for response will result in **ABANDONMENT** of the application (see 35 U.S.C 133,

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M.P.E.P 710.02, 710.02(b)).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Krisna Lim whose telephone number is 571-272-3956. The examiner can normally be reached on Monday to Friday from 9:30 AM to 6:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ario Etienne, can be reached on 571-272-4001. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

KI

March 28, 2009

/Krisna Lim/

Primary Examiner, Art Unit 2453